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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,383	07/28/2000	Paul T. Matsudaira	0399.1211-001	3215

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EXAMINER

COOK, LISA V

ART UNIT	PAPER NUMBER
1641	17

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,383

Applicant(s)

MATSUDAIRA ET AL.

Examiner

Lisa V. Cook

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, are drawn to an affinity fluorescent protein comprising a fluorescent protein molecule such as GFP along with a heterologous amino acid sequence, classified in class 530, subclass 300 and class 530, subclass 350.
 - II. Claims 11-15, are drawn to an affinity fluorescent protein expression cassette/vector a modified GFP and a nucleic acid sequence operatively linked to an expression control sequence comprising a modification between (Gln) 157 and (Lys)158 and/or between (Glu)172 and (Asp)173, classified in class 536, subclass 23.1.
 - III. Claims 16-18, are drawn to a host cell, classified in class 435, subclass 325.
 - IV. Claims 19-23, are drawn to a method of detecting the presence of a target ligand in a mixture of macromolecules, classified in class 436, subclass 501.
 - V. Claims 24-26, are drawn to a method of detecting the occurrence of a target ligand in a cell, classified in class 435, subclass 7.21.
 - VI. Claims 27-29 are drawn to an isolated affinity fluorescent protein expression cassette comprising SEQ ID NO:1 and a substitution of serine at position 147 of GFP to Proline (Ser147Pro), classified in class 536, subclass 23.1.
2. The inventions are distinct, each from the other because of the following reasons:

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Inventions **I, II, III, and VI** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions are drawn to a plurality of patentably distinct compositions having diverse structural limitations. Group I comprises amino acid sequences, Group II comprises nucleic acid sequences comprising a modification between (Gln) 157 and (Lys)158 and/or between (Glu)172 and (Asp)173, Group III comprises a host cell, while Group VI comprises nucleic acid sequences comprising SEQ ID NO:1 and a substitution of serine at position 147 of GFP to Proline (Ser147Pro).

With respect to the separate amino acid structures and the nucleic acid structures, they bear distinct structural or biochemical properties having different binding epitopes (Specification references sequence id. Nos. 1-13). **Therefore, each disclosed patentably distinct amino acid sequences and nucleic acid sequence is considered a separate invention.** See Official Gazette 1232 OG 242(116) March 21, 2000. Therein the O.G. notice permits the examiner to examine up to ten sequences per application based on the use of US PTO resources. Resources are now stretched to the limit, such that only one sequence should be searched per application. It is recognized that although the search for the inventions may overlap they are not totally co-extensive, where by the search for one would fully encompass the search for the others.

Because these inventions are distinct for the reasons given above and the search required for each sequence is not mutually inclusive (i.e. the search for one invention is not required for the other inventions) restriction for examination purposes as indicated is proper.

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The method inventions of IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, inventions IV and V have different modes of operation and detect different effects. Although both methods detect a target ligand, they have different modes of operation effect different materials (Invention IV detection is in a mixture of macromolecules while Invention V detection is in a cell). Therein the methods are diverse and independent employing different reagents and have different method steps.

Inventions (I, II, III, VI) and (IV, V) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the methods-process for using in inventions IV and V can be practiced with either of the materially different products found in inventions I, II, III, or VI.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Please note that the classifications in the restriction are illustrative only and **do not** represent all the classes and subclasses which must be searched for each invention; nor is the search limited to issued US patents, but rather includes foreign patents and applications as well as literature searches.

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4. A telephone call was made to Anne J. Collins (Reg. No. 40,564) on 4/15/03 to request an oral election to the above restriction requirement, but did not result in an election being made

5. Applicant is advised that the reply to this requirement be complete and must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242, which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday – Friday from 8:00AM – 4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.




Lisa P. Cook

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CM1-7B17

(703) 305-0808

April 15, 2003



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

04/21/03